

REMARKS

Claims 7 to 24 are now pending in the present application.

In view of the following remarks, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is therefore respectfully requested.

Claims 7, 8, 17, 18, and 23 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 4,700,020 to Michaels-Krohn et al., (“MK”), in view of U.S. Patent No. 6,118,729 to Aulia et al. (“Aulia”), in view of U.S. Patent No. 6,026,074 to Stadler (“Stadler”), in view of U.S. Patent No. 6,118,729 to Hirabayashi et al. (“Hirabayashi”), in view of U.S. Patent No. 6,515,930 to Jacquet et al. (“Jacquet”).

To reject a claim under 35 U.S.C. § 103(a), the Office bears the initial burden of presenting a *prima facie* case of obviousness. *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish *prima facie* obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

Also, as clearly indicated by the Supreme Court in *KSR*, it is “important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements” in the manner claimed. *See KSR Int’l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727 (2007). In this regard, the Supreme Court further noted that “rejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *Id.*, at 1396. Second, there must be a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim features. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

Claim 7 is to a data transmission path arrangement, which includes: a ***first data modification device*** located on the ***sender side***; a ***second data modification device*** located on the ***receiver side***, the first data modification device and the second data modification device each have the ***same transmission function effecting a modification of input data into output data*** and are ***connected to the data transmission path***; and in which a transmission of the input data, generated on the ***sender side***, to the first data modification device and a transmission of identical

input data to the *second data modification device via the data transmission path occur on the data transmission path.*

The Office Action concedes that the primary MK reference does not disclose the above identified features. (See Office Action, page 4.) As to the Aulia reference, it does not cure the critical deficiencies of the MK reference.

In particular, claim 7 requires a *first data modification device* to be located on the *sender side* and a *second data modification device* to be located on the receiver side. The data generated on the *sender side* is transmitted via the data *transmission path* to the *second data modification device*. For example, figure 1 of the present application shares an embodiment of this arrangement. In stark contrast to the claimed subject matter, Aulia merely refers to *a single “device 1”*. (See Aulia, column 3, lines 39 to 43; and Figure 1.) Even if Aulia did have an input and output for the device, it does not disclose two separate devices -- one on the *sender side* and one on the *receiver side* with respect to a *data transmission path*, as provided for in the context of the presently claimed subject matter.

Accordingly, the Aulia reference does not disclose a first data modification device on the sender side and a second data modification device located on the receiver side, in which data generated on the sender side is transmitted to the second data modification device via the data transmission path, as provided for in the context of the claimed subject matter. The Hirabayashi and Jacquet references do not cure – and are not asserted to cure – the critical deficiency of the MK and Aulia combination.

Further, claim 7 includes a comparator located on the receiver side and connected to the data transmission path and the second data modification device, in which the comparator compares the output data supplied by the first data modification device and the second data modification device via the data transmission path, and in which the *comparator activates the enabling device when the output data of the first data modification device and the second modification device are identical.*

The Supreme Court has made plain that to sustain an obviousness rejection, it is “important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements” in the manner claimed (see *KSR Int’l Co. v. Teleflex, Inc.*, 82 U.S.P.Q.2d 1385 (2007), and it has further stated that “rejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some

articulated reasoning with *some rational underpinning* to support the legal conclusion of obviousness.” (*Id.* at 1396).

The Office Action has not provided any “articulated reasoning with *some rational underpinning* to support the legal conclusion of obviousness”, since it relies on “mere conclusory statements.” It is respectfully submitted that prior art references must be considered as a whole -- including portions that teach away from the claimed subject matter. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540 (Fed. Cir. 1983).

In this regard, the primary MK reference specifically states that it is an object of their invention to provide a method “with minimal circuit outlay.” (MK, column 2, lines 1 to 2.) Indeed, the MK reference specifically states that “[n]o separate devices are additionally required for attaching the auxiliary information.” (MK, column 2, lines 67-68.) Since MK makes it a goal to minimize circuitry, one skilled in the relevant art would not find it obvious to combine a reference that is in itself complete, with four additional references (i.e., Aulia, Stadler, Hirabayashi, and Jacquet) that would add additional circuitry. Indeed, the primary MK reference specifically teaches away from any such combination, since their object is to minimize circuitry - and not to expand it.

Still further, the two memory units 12 and 13 in the “Aulia” reference simply do not have the “same transmission function”, as provided for in the context of the presently claimed subject matter. This is because the “Aulia” reference clearly indicates that they have stored modifications of a “first type” and a “second type”, respectively, and that they are used alternatively by the use of through-coupling structure 14.

It is therefore respectfully submitted that claim 7 is allowable, as are its dependent claims 8, 17, 18, and 23. Withdrawal of the obviousness rejections is therefore respectfully requested.

Claim 13 was rejected under 35 U.S.C. § 103(a) as being unpatentable over the Aulia reference, in view of the Hirabayashi reference, in view of the Jacquet reference.

Claim 14 was rejected under 35 U.S.C. § 103(a) as being unpatentable over the Aulia reference, in view of the Hirabayashi reference, in view of the Jacquet reference, in view of the Nakatsugawa reference.

Although the rejections may not be agreed with, to facilitate matters, claim 13 has been rewritten without prejudice to include the features of claim 7, and it is therefore allowable for the same reasons, as is its dependent claim 14.

Claims 9, 10, and 19 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the MK reference, in view of the Aulia reference, in view of the Stadler reference, in view of the Hirabayashi reference, in view of the Jacquet reference, and in view of U.S. Patent No. 6,470,012 to Nakatsugawa ("Nakatsugawa").

Claims 9, 10, and 19 ultimately depend from independent claim 7, and they are allowable for essentially the same reasons as claim 7, since the secondary Nakatsugawa reference does not cure -- and is not asserted to cure -- the critical deficiencies of the primary references. For at least this reason claims 9, 10, and 19 are allowable.

Claim 15 was rejected under 35 U.S.C. § 103(a) as being unpatentable over the MK reference, in view of the Aulia reference, in view of the Stadler reference, in view of the Hirabayashi reference, in view of the Jacquet reference, and in view of the Nakatsugawa reference.

Claim 15 depends from independent claim 7, and it is therefore allowable for essentially the same reasons as claim 7, since the secondary Nakatsugawa reference does not cure -- and is not asserted to cure -- the critical deficiencies of the primary references. For at least this reason claim 15 is allowable.

Claims 11 and 12 were rejected under 35 U.S.C. § 103(a) as being obvious over the MK reference, in view of the Aulia reference, in view of the Stadler reference, in view of the Hirabayashi reference, in view of the Jacquet reference, and in view of U.S. Patent No. 4,852,680 to Brown et al., ("Brown").

Claims 11 and 12 ultimately depend from independent claim 7, and they are therefore allowable for essentially the same reasons as independent claim 7, since the secondary Brown reference does not cure -- and it is not asserted to cure -- the critical deficiencies of the primary references. For at least this reason, claims 11 and 12 are allowable.

Claim 16 was rejected under 35 U.S.C. § 103(a) as being obvious over the MK reference, in view of the Aulia reference, in view of the Stadler reference, in view of the

Hirabayashi reference, in view of the Jacquet reference, and in view of U.S. Application No. 2006/0273878 to Michmerhuizen et al., ("Michmerhuizen").

Claim 16 depends from independent claim 7, and it is therefore allowable for essentially the same reasons as independent claim 7, since the secondary Michmerhuizen reference does not cure -- and it is not asserted to cure -- the critical deficiencies of the primary references. For at least this reason, claim 16 is allowable.

Claims 20 to 22 were rejected under 35 U.S.C. § 103(a) as being obvious over the MK reference, in view of the Aulia reference, in view of the Stadler reference, in view of the Hirabayashi reference, in view of the Jacquet reference, in view of the Nakatsugawa reference, and in view of the Brown reference.

Claims 20 to 22 ultimately depend from independent claim 7, and they are therefore allowable for essentially the same reasons as independent claim 7, since the secondary Nakatsugawa and Brown references do not cure -- and are not asserted to cure -- the critical deficiencies of the primary references. For at least this reason, claims 20 to 22 are allowable.

Claim 24 was rejected under 35 U.S.C. § 103(a) as being obvious over the MK reference, in view of the Aulia reference, in view of the Stadler reference, in view of the Hirabayashi reference, in view of the Jacquet reference, and in view of the Brown reference

Claim 24 ultimately depends from independent claim 7, and it is therefore allowable for essentially the same reasons as independent claim 7, since the secondary Brown reference does not cure -- and it is not asserted to cure -- the critical deficiencies of the primary references. For at least this reason, claim 24 is allowable.

As further regards all of the obviousness rejections, any Official Notice is respectfully traversed to the extent that it is maintained and it is requested that the Examiner provide specific evidence to establish those assertions and/or contentions that may be supported by the Official Notices under 37 C.F.R. § 1.104(d)(2) or otherwise. In particular, it is respectfully requested that the Examiner provide an affidavit and/or that the Examiner provide published information concerning these assertions. This is because the § 103 rejections are apparently being based on assertions that draw on facts within the personal knowledge of the Examiner, since no support was provided for these otherwise conclusory and unsupported assertions. (See also MPEP § 2144.03).

In view of the foregoing, withdrawal of the obviousness rejections is respectfully requested.

Accordingly, claims 7 to 24 are allowable.

**CONCLUSION**

In view of the foregoing, it is respectfully submitted that the pending claims are allowable. It is therefore respectfully requested that the rejections (and any objections) be withdrawn. Prompt reconsideration and allowance of the present application are therefore respectfully requested.

Respectfully submitted,

KENYON & KENYON LLP

Dated: \_\_\_\_\_

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By: \_\_\_\_\_

Gerard A. Messina  
(Reg. No. 35,952)

One Broadway  
New York, NY 10004  
(212) 425-7200

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